

REMARKS

The Official Action dated March 21, 2002, has been carefully considered. Accordingly, the changes and remarks presented herewith are believed sufficient to place the present invention in condition for allowance. Reconsideration is respectfully requested.

Claims 1, 11, 12 and 15 have been amended finding support in the specification and drawings as filed. Attached hereto is "**Version with Markings to Show Changes Made,**" showing the changes made to the claims by the current amendment. It is believed that these changes do not involve any introduction of new matter, whereby entry is believed to be in order and is respectfully requested. Claims 1-19 remain in the case for consideration.

In the Official Action, claims 1-7, 9 and 11-13 were rejected under 35 U.S.C. § 102(e) as being anticipated by Itoh (U.S. Patent No. 6,043,785). The Examiner asserted that Itoh teaches a printer configuration comprising a computer readable medium comprising data, a computer having access to the data on the computer readable medium, a communication link connected to the computer, a photoprinter connected to the communication link and in communication with the computer, the photoprinter having a selection mechanism, and having access to the data over the communication link and memory in response to the user's input to the selection mechanism on the photoprinter.

However, as will be set forth in detail below, it is submitted that the printer configurations and methods for accessing digital photographs defined by claims 1-7, 9 and 11-13 are not anticipated by the teachings of Itoh. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, from which claims 2-10 depend, the present invention is directed towards a printer configuration, comprising a computer readable medium comprising data, a computer having access to the data on the computer readable medium, a communication link connected to the computer, a photoprinter connected to the

communication link and in communication with the computer, wherein the photoprinter has a selection mechanism and has access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter, wherein the photoprinter comprises a stand-alone printer capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device.

Itoh discloses a digital print system, wherein the digital print system comprises an image input device, a controller, a printer, a display, a memory device, an input device, and a bonding machine for bonding a print in which characters and an image output from the printer are synthesized onto a base card such as a New Year's card or standard postal card. In the Official Action the Examiner has asserted that the digital print system 10 shown in Fig. 1 of Itoh is a photoprinter. However, the Examiner's attention is directed to column 6, lines 4-39 of Itoh which teaches the digital print system 10 is a printer configuration which comprises multiple components, of which one component is a printer 16. Furthermore, Itoh fails to teach or suggest a photoprinter as set forth by the present invention. As defined by the present invention, a photoprinter comprises a stand-alone printer for printing digital photographs onto a printable medium. The printer of Itoh fails to teach or suggest a stand-alone printer for printing digital photographs onto a printable medium. In addition, as described by the present invention, a stand-alone printer means that the printer is capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, with both the calculating and printing being independent of an external host device, such as a computer. Once again, Itoh fails to teach or suggest a printer, which is capable of processing and printing digital files independent of an external host device, such as a computer.

In addition, Itoh fails to teach or suggest a photoprinter having a selection mechanism on the photoprinter, which allows access to data over a communication link in response to a

user's input to the selection mechanism on the photoprinter. The Examiner has asserted that the selection mechanism (22a and 22b) in Fig. 1 of Itoh is on the printer 16. While Itoh discloses a data input device 22 (see column 6, lines 4-39), the data input device (22a and 22b) is not on the printer, but rather is in communication with the controller 14 which is also in communication with the printer 16 (see Fig. 1 of Itoh).

Applicants find no teaching or suggestion by Itoh of a photoprinter as defined by the present invention. In addition, Applicants find no teaching or suggestion by Itoh of a selection mechanism on the photoprinter as set forth by the present claims.

Rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989), *cert denied*, 493 U.S. 853 (1989). Applicants are unable to find any teaching or disclosure by Itoh of a photoprinter comprising a stand-alone printer for printing digital photographs onto a printable medium. Moreover, Applicants find no teaching or suggestion by Itoh of a selection mechanism on the photoprinter, wherein the selection mechanism has access to data over the communication link in response to user's input to the selection mechanism on the photoprinter.

Further, the reference must describe the Applicant's claimed invention sufficiently to place a person of ordinary skill in the field of the invention in possession of it. *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986), *cert denied*, 482 U.S. 909 (1987); *In re Coker*, 463 F.2d 1344, 1348, 175 U.S.P.Q. 26, 29 (CCPA 1972). To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 U.S.P.Q.2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001,

1010 (Fed. Cir. 1991). Applicants find no teaching or disclosure in Itoh of a photoprinter connected to the communication link of the printer configuration. The photoprinter as defined by the present invention means a stand-alone printer for printing digital photographs onto a printable medium. By stand-alone, means that the printer is capable of processing and printing digital files independent of external host devices, such as a computer, wherein processing comprises calculating a pixel pattern to be printed on the printable medium that represents the corresponding digital file (see p. 3, lines 19-30 of the present application). When the meaning of a term used in a claim is sufficiently clear from its definition in the patent specification, that meaning shall apply. *Intermatic Inc. v. Lamson & Sessions Co.*, 273 F.3d 1355, 1365, 61 U.S.P.Q.2d 1075, 1082 (Fed. Cir. 2001); *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477, 45 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1998); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 U.S.P.Q.2d 1383, 1387 (Fed. Cir. 1992). Furthermore, Applicants find no teaching or suggestion of a photoprinter having a selection mechanism and having access to the data over the communication link in response to a user's input to selection mechanism on the photoprinter as set forth in the present invention. Itoh fails to teach or suggest a photoprinter with a selection mechanism, therefore Itoh fails to anticipate the presently claimed printer configuration.

The present invention as defined by claim 11 comprises a printer configuration comprising a computer having a plurality of digital photographs on a computer readable medium, a communication link connected to the computer, and a photoprinter connected to the computer via the communication link wherein the photoprinter has means for accessing the digital photographs, wherein the photoprinter comprises a stand-alone printer capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device.

As noted above, Itoh fails to teach or suggest a photoprinter and a photoprinter having means for accessing digital photographs. The Examiner's rejection identifies the means as being represented by 22a and 22b in Fig. 1 of Itoh for accessing the digital photographs through what the Examiner refers to as the photoprinter. However, the Applicants wish to direct the Examiner's attention to Fig. 1 of Itoh, wherein the printer 16 is independent from the input means 22a and 22b. Itoh teaches a digital print system comprised of a configuration of multiple components, wherein one component is a printer 16 (see column 6, lines 1-40), as opposed to a photoprinter as defined by the present invention.

Furthermore, Itoh fails to teach or suggest that the input means 22a and 22b have the capability for accessing digital photographs over the communication link to the computer having a plurality of digital photographs on the computer readable medium. As noted above, a rejection for anticipation for lack of novelty requires, as a first step, that all the elements of the claimed invention be described in a single reference. *Richardson v. Suzuki Motor Co.*, *supra*. Itoh fails to teach or suggest a photoprinter in a printer configuration, wherein the photoprinter is connected to a computer via a communication link and the photoprinter has means for accessing the digital photographs through the communication link to the computer having a plurality of digital photographs on a computer readable medium. Thus, Itoh by its failure to teach or suggest all the claimed elements does not anticipate the Applicant's claimed invention.

As defined by claim 12, from which claim 13 depends, the present invention is directed towards a method for accessing digital photographs. The method comprises the steps of placing one or more digital photographs on a computer; establishing a communication link between a photoprinter and the computer, wherein the photoprinter comprises a stand-alone printer capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of

an external host device; inputting a request to the photoprinter by a user; and accessing the digital photographs by the photoprinter in response to the request.

As noted above, Itoh fails to teach or suggest a photoprinter and a photoprinter having means for accessing digital photographs. The Examiner's rejection identifies the means as being represented by 22a and 22b in Fig. 1 of Itoh for accessing the digital photographs through what the Examiner refers to as the photoprinter. However, the Applicants wish to direct the Examiner's attention to Fig. 1 of Itoh, wherein the printer 16 is independent from the input means 22a and 22b. Itoh teaches a digital print system comprised of a configuration of multiple components, wherein one component is a printer 16 (see column 6, lines 1-40), as opposed to a photoprinter as defined by the present invention.

Furthermore, Itoh fails to teach or suggest that the input means 22a and 22b have the capability for accessing digital photographs over the communication link to the computer having a plurality of digital photographs on the computer readable medium. As noted above, a rejection for anticipation for lack of novelty requires, as a first step, that all the elements of the claimed invention be described in a single reference. *Richardson v. Suzuki Motor Co.*, *supra*. Itoh fails to teach or suggest a method for accessing digital photographs, wherein a photoprinter is connected to a computer by establishing a communication link, wherein the photoprinter accesses the digital photographs from the computer where a request by a user is inputted to the photoprinter. Thus, Itoh by its failure to teach or suggest all the claimed elements of the Applicant's claimed invention does not support a rejection under 35 U.S.C. § 102. It is therefore submitted that the presently claimed printer configurations and methods as set forth by claims 1-7, 9 and 11-13, are not anticipated by Itoh, whereby rejection under 35 U.S.C. § 102(e) has been overcome. Reconsideration is respectfully requested.

In the Official Action, the Examiner rejected claims 15-17 under 35 U.S.C. § 102(b) as being anticipated by Colbert et al. (U.S. Patent No. 5,699,494). The Examiner asserted

that Colbert et al. teach a method for diagnosing a printer, including the steps of obtaining a stand-alone printer, establishing a communication link between the stand-alone printer and a computer, transmitting instructions over the communication link from the computer to the stand-alone printer and diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions.

However, as will be set forth in detail below, it is submitted that the methods for diagnosing a printer set forth by claims 15-17 are not anticipated by Colbert et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 15, from which claims 16 and 17 depend, the present invention is directed towards a method for diagnosing a printer comprising the steps of obtaining a stand-alone printer, wherein the stand-alone printer is capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device; establishing a communication link between the stand-alone printer and a computer; transmitting instructions over the communication link from the computer to the stand-alone printer; and diagnosing the one or more functions of the stand-alone printer in accordance with the transmitted instructions.

Colbert et al. disclose a remote replication of a printer operation panel between a host computer and a conventional printer connected to the host, either locally or by way of a network. The host computer is provided with access to a visual and functional replica of the operator panel of the printer. The user may view the replica to access all data available through the printer operational panel.

The present invention as defined by claim 15 includes a stand-alone printer. Colbert et al. fail to teach or suggest a stand-alone printer. A stand-alone printer is a printer capable of capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device (see p.

3, lines 15-30 of the present application). The Examiner asserted in the rejection that the printer 16 in Fig. 1 of Colbert et al. is a stand-alone printer. However, Applicants find no teaching or suggestion that the conventional printer 16 in Fig. 1 is a stand-alone printer or has stand-alone capabilities or functionality as set forth in the present invention. In addition, the Examiner asserted that the controller 72 of Fig. 3 of Colbert et al. could process a print job independent from a host, and is therefore a stand-alone printer. Once again, Applicants find no teaching or suggestion that the printer controller 72 in Fig. 3 is a stand-alone printer or has stand-alone capabilities or functionality as set forth in the present invention. Furthermore, Applicants find no teaching or suggestion from Colbert et al. of a stand-alone printer having the capability of diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions from an external host as set forth in the present invention. In order for a reference to anticipate, every element and limitation of the claimed invention must be found in the single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co., supra*. A rejection for anticipation or lack of novelty requires, as a first step in the inquiry, that all the elements of the claimed invention be described in a single reference. *Richardson v. Suzuki Motor Co., supra*. Further, the reference must describe the Applicants' claimed invention sufficiently to place a person of ordinary skill in the art of the invention in possession of it. *Akzo N.V. v. United States Int'l Trade Comm'n, supra*. Finding no teaching or suggestion in Colbert et al. of a stand-alone printer or a printer having the capability of diagnosing one or more functions of a stand-alone printer, Colbert et al. fail to teach or suggest the methods for diagnosing a printer as currently defined by claims 15-17, and therefore, do not anticipate the presently claimed invention. Whereby, the rejection has been overcome and reconsideration is respectfully requested.

In the Official Action, claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh as applied to claim 1 above, and further in view of Satomi et al. (U.S.

Patent No. 4,759,053). The Examiner noted that Itoh does not teach the communication link comprising a modem connection. The Examiner asserted that Satomi et al. teach to use a modem connecting a computer and a printing device as a communication link. The Examiner asserted that it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Itoh to include a modem connection as a communication link. The Examiner also asserted that it would have allowed the printer and the computer to be far apart and a user would still use the system, and using a modem connection would have allowed the printer and computer to be located at any location so long as there is a phone line and would have provided users with convenience.

However, as will be set forth in detail below, it is submitted that the printer configuration of claim 8 is non-obvious and patentably distinguishable from the teachings of Itoh in further view of Satomi et al. Accordingly this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 8, the present invention is directed towards a printer configuration of claim 1, wherein the communications link is a modem connection.

As noted above, Itoh discloses a digital print system that lacks several features and elements of the claimed invention. These missing features include a photoprinter connected to the communication link and in communication with the computer, wherein the photoprinter has a selection mechanism having access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter. As noted above, the printer of Itoh does not have a selection mechanism on the printer.

Satomi et al. disclose a facsimile/character communication system capable of transmitting or receiving character data through a host computer intermediately storing the character or picture data.

In order for references to be relied upon to support a rejection under 35 U.S.C. § 103 they must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *Glaxo Inc. v. Novopharm Ltd.*, 34 U.S.P.Q.2d, 1565 (Fed. Cir. 1995); *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979).

Applicants find no teaching or suggestion by Itoh alone or in combination with Satomi et al. of a photoprinter. As defined by the present invention, a photoprinter comprises a stand-alone printer for printing digital photographs onto a printable medium. In addition, Itoh and Satomi et al., alone or in combination, fail to teach or suggest a photoprinter having a selection mechanism on the photoprinter.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). In view of the failure of Itoh and Satomi et al., alone or in combination, to teach, disclose or suggest a photoprinter with a selection mechanism on the photoprinter, Itoh and Satomi et al. do not render the presently claimed printer configurations obvious. It is therefore submitted that the presently claimed printer configurations are non-obvious over and patentably distinguishable from Itoh in view of Satomi et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

In the Official Action, claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Itoh and further in view of Bahreman (U.S. Patent No. 6,061,665). The Examiner noted that Itoh does not teach the data being accessible on an online account. The Examiner asserted that Bahreman teaches that data from a server is accessible on an online account. The Examiner asserted that it would have been obvious to a person of ordinary skill in the art to modify Itoh to include print data accessible on an online account.

However, as will be set forth in detail below, it is submitted that the printer configuration of claim 10 is non-obvious and patentably distinguishable over the teachings of Itoh in further view of Bahreman.

As defined by claim 10, the present invention is directed towards a printer configuration of claim 1, wherein the computer is a server, and wherein the data is accessible on an online account. As noted above, Itoh fails to teach or suggest a printer configuration where the data is accessible from an online account.

Bahreman discloses a system for secure, electronic payment in exchange for goods and services purchased over a communication network utilizing a negotiated, mutually accepted payment processing method for a customer to a merchant utilizing a network.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Similarly, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive in supporting the combination. *In re Geiger*, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1987). There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination of the references. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1993). Applicants find no such teaching, suggestion or incentive for the combination of Itoh and Bahreman. One skilled in the art would not have been motivated to combine the e-commerce payment system of Bahreman with the image synthesizing method of Itoh.

It is therefore submitted that the presently claimed printer configurations are non-obvious over and patentably distinguishable from Itoh in view of Bahreman, whereby the

rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Itoh in further view of Lightenberg et al. (U.S. Patent No. 5,682,441). The Examiner noted that Itoh does not teach or suggest downloading thumbnail representations of digital photographs. The Examiner asserted that Lightenberg et al. teach downloading thumbnail representations of the digital photographs. The Examiner asserted that it would have been obvious to a person with ordinary skill in the art at the time the invention was made, to modify Itoh to include downloading thumbnail representations of the digital photographs.

However, as will be set forth in detail below, it is submitted that the method for accessing digital photographs of claim 14 is non-obvious and patentably distinguishable from the teachings of Itoh in further view of Lightenberg et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 14, the present invention is directed toward a method for accessing digital photographs. The method comprises the steps of placing one or more digital photographs on a computer; establishing a communication link between a photoprinter and the computer, wherein the photoprinter comprises a stand-alone printer capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device; inputting a request to the photoprinter by the user; and accessing the digital photographs on the photoprinter in response to the request, wherein the step of accessing comprises downloading thumbnail representations of the digital photographs.

As noted above, Itoh fails to teach or suggest a stand-alone photoprinter. Furthermore, Applicants find no teaching or suggestion of a photoprinter with the ability to access digital photographs in response to a user's request on the photoprinter.

Lightenberg et al. disclose image data formats and techniques for selectively storing and retrieving image data.

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne, supra*. The deficiencies of Itoh noted above are not overcome by the combination of Lightenberg et al. Applicants find no teaching or suggestion by Itoh or Lightenberg et al., alone or in combination, of a photoprinter as set forth in the present invention. In addition, Itoh and Lightenberg et al., alone or in combination, fail to teach or suggest a photoprinter with the ability to access digital photographs in response to a user's request on the photoprinter.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka, supra*. In view of the failure of Itoh and Lightenberg et al., alone or in combination, to teach or suggest a photoprinter having the ability of accessing digital photographs in response to requests input to the photoprinter. Itoh and Lightenberg et al. do not render the presently claimed methods of accessing digital photographs obvious. It is therefore submitted that the presently claimed methods are non-obvious over and patentably distinguishable from Itoh in view of Lightenberg et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Colbert et al. in further view of Itoh. The Examiner noted that Colbert et al. do not teach or suggest that the stand-alone printer is a photoprinter. The Examiner asserted that Itoh teaches that the stand-alone printer is a photoprinter. The Examiner asserted that it would have been obvious for a person with ordinary skill in the art to have modified Colbert et al. with the photoprinter of Itoh.

However, as will be set forth in detail below, it is submitted that the method for diagnosing a printer of claim 18 is non-obvious and patentably distinguishable from the teachings of Colbert et al. in view of Itoh. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 18, the present invention is directed towards a method for diagnosing a printer. The method comprises the steps of obtaining a stand-alone printer, wherein the stand-alone printer is capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device; establishing a communication link between the stand-alone printer and a computer; transmitting instructions over the communication link from the computer to the stand-alone printer; and diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions, wherein the stand-alone printer is a photoprinter.

As noted above, Colbert et al. disclose a remote replication of a printer operation panel between a host computer and a conventional printer connected to the host, either locally or by way of a network. Colbert et al. fail to teach or suggest a stand-alone printer. As defined by the present invention, a stand-alone printer is capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device, such as a computer.

Furthermore, as noted earlier, Itoh fails to teach or suggest a stand-alone printer for printing digital photographs onto a printable medium, and Itoh fails to teach or suggest a stand-alone printer, which is capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device, such as a computer.

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne, supra*. Moreover, obviousness cannot be established by combining the teachings of prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting this combination. *In re Geiger, supra*. Applicants find no teaching, suggestion or incentive by Colbert et al. and Itoh, alone or in combination, of a stand-alone printer as defined by the present invention. Furthermore, Applicants find no teaching in Itoh of a stand-alone printer as defined by the present invention.

To establish prima face obviousness of the claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka, supra*. In view of the failure of Colbert et al. and Itoh, alone or in combination, to suggest a stand-alone printer, Colbert et al. and Itoh do not render the presently claimed methods for diagnosing a printer obvious. It is therefore submitted that the presently claimed methods are non-obvious and patentably distinguishable from Itoh in view of Colbert et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Colbert et al. in view of Overall et al. (U.S. Patent No. 5,797,061). The Examiner noted that Colbert et al. fail to teach or suggest a computer receiving usage statistics of the stand-alone printer. The Examiner asserted that Overall et al. teach having a computer receive usage statistics of the printer. The Examiner asserted that it would have been obvious to one skilled in the art to modify Colbert et al. with Overall et al.

However, as will be set forth in detail below, it is submitted that the method for diagnosing a printer of claim 19 is non-obvious and patentably distinguishable from the teachings of Colbert et al. in view of Overall et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 19, the present invention is directed towards a method for diagnosing a printer. The method comprises the steps of obtaining a stand-alone printer, wherein the stand-alone printer is capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device; establishing a communication link between the stand-alone printer and a computer; transmitting instructions over the communication link from the computer to the stand-alone printer; diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions; and receiving usage statistics of the stand-alone printer by the computer.

Overall et al. disclose a printer that calculates the remaining amount of pages that can be printed and the amount of time before the ink cartridge becomes empty.

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne, supra*. The deficiencies of Colbert et al. noted above are not overcome by the combination of Overall et al. Applicants find no teaching or suggestion by Colbert et al. and Overall et al., alone or in combination, of a stand-alone printer as defined by the present invention.

In view of the failure of Colbert et al. and Overall et al., alone or in combination, to teach or suggest a stand-alone printer, Colbert et al. and Overall et al. do not render the presently claimed methods of diagnosing a printer obvious. It is therefore submitted that the presently claimed methods are non-obvious and patentably distinguishable from Colbert et al. in view of Overall et al., whereby the rejection under 35 U.S.C. §103 has been overcome, reconsideration is respectfully requested.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§102 and 103 and places the present invention in condition for allowance. Reconsideration and an early allowance are respectfully requested.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claims 1, 11, 12 and 15 have been amended as follows:

1. (Amended) A printer configuration, comprising:
 - a) a computer readable medium comprising data;
 - b) a computer having access to the data on the computer readable medium;
 - c) a communication link connected to the computer; and
 - d) a photoprinter connected to the communication link and in communication with the computer, the photoprinter having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter, wherein the photoprinter comprises a stand-alone printer capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device.

11. (Amended) A printer configuration, comprising:
 - a) a computer having a plurality of digital photographs on a computer readable medium;
 - b) a communication link connected to the computer; and
 - c) a photoprinter connected to the computer via the communication link, the photoprinter having means for accessing the digital photographs, wherein the photoprinter comprises a stand-alone printer capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device.

12. (Amended) A method for accessing digital photographs, the method comprising the steps of:

- a) placing one or more digital photographs on a computer;
- b) establishing a communication link between a photoprinter and the computer, wherein the photoprinter comprises a stand-alone printer capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device;
- c) inputting a request to the photoprinter by a user; and
- d) accessing the digital photographs by the photoprinter in response to the request.

15. (Amended) A method for diagnosing a printer, the method comprising the steps of:

- a) obtaining a stand-alone printer, wherein the stand-alone printer is capable of calculating a pixel pattern to be printed on a printable medium and printing digital files, the calculating and printing being independent of an external host device;
- b) establishing a communication link between the stand-alone printer and a computer; [and]
- c) transmitting instructions over the communication link from the computer to the stand-alone printer; and
- d) diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions.